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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>Q137-US5</b>
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>	<p>Application Number <b>10/666,873</b></p>	<p>Filed <b>September 17, 2003</b></p>
<p>First Named Inventor <b>Hisashi Tsukamoto et al.</b></p>		
<p>Art Unit <b>1745</b></p>		<p>Examiner <b>Dah Wei D. Yuan</b></p>
<p>Applicant requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.</p>  <p>This request is being filed with a notice of appeal.</p>  <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>  <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,491</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <div style="text-align: right; margin-top: 20px;"> _____ Signature  _____ Travis Dodd Typed or printed name  _____ 818-833-2003 Telephone number  _____ 07/02/2007 Date</div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>		
<p><input checked="" type="checkbox"/> *Total of _____ forms are submitted.</p>		

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PATENT  
Docket No. Q137-US5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hisashi Tsukamoto et al.

Serial No: 10/666,873

Filed: September 17, 2003

For: ELECTRIC STORAGE BATTERY  
CONSTRUCTION AND METHOD OF  
MANUFACTURE

Art Unit: 1745

Examiner: YUAN, Dah Wei D.

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Pre-Appeal Brief Request for Review**

This communication is in response to the Office Action mailed on March 12, 2007 (the Office Action). Pending claims 39-41 and 71-80 are rejected for statutory double patenting over the claims of co-pending U.S. Patent Application serial number 10/666,860 (the cited Application). The Applicant submits that a clear legal error has been committed in rejecting claims 39-41 and 71-80 for statutory double patenting.

**REMARKS**

**The Pending Claims**

Claim 39 is the only independent claim pending in the current application. Claim 39 is directed to a method of constructing an electrode assembly. The method includes positioning a mandrel on a pin such that a portion of a first electrode strip is positioned between the mandrel and the pin. The method also includes winding the first electrode strip together with a second electrode strip so as to form a spiral roll, the spiral roll being formed after positioning the mandrel on the pin.

**Rejection of Claims Under 35 USC §101**

Pending claims 39-41 and 71-80 are rejected for statutory double patenting over the claims of co-pending U.S. Patent Application serial number 10/666,860 (the cited Application). This rejection is for statutory double patenting as opposed to nonstatutory double patenting. Accordingly, this rejection requires that the claims are to the same invention.

**Applicant has not been offered the opportunity to elect**

This rejection is double patenting in view of a pending patent application rather than in view of an issued patent. The statutory double patenting rejection is the only rejection left in both application. The third paragraph of MPEP 804(I)(B)(2) applies to exactly this situation and provides the following:

If a "provisional" statutory double patenting rejection is the only rejection remaining in both applications, the examiner should withdraw that rejection in the application with the earlier filing date and permit that application to issue as a patent. If both applications were filed on the same day, the applicant should be given an opportunity to elect which of the two should be allowed.

Since the immediate application and the cited application were filed on September 17, 2003, the "the applicant should be given an opportunity to elect which of the two should be allowed." The Applicant has not been offered this opportunity in either the immediate application or in the cited application. For this reason alone, the statutory double patenting rejection should be withdrawn and the Applicant should be given the opportunity to elect which Application should be allowed.

**The claims in the immediate application and in the cited application are directed to different inventions.**

A statutory double patenting rejection is not supported unless the claims in the conflicting patent applications are directed to the same invention (MPEP §804.02). However, the claims in the cited application have a different scope from the pending claims.

The Office Action appears to indicate that claim 81 of the cited application conflicts with claim 79 of the current Application. However, claim 81 of the cited application depends

from claim 20 which recites “at least a portion of the pin within the spiral roll.” This limitation is not included in claim 79 of the current application. Further, the prosecution history shows that this language makes claim 81 in the cited application patentably distinct from claim 79 in the current application. For instance, this Application and the cited application are each a Divisional of U.S. Patent Applications serial number 10/167,688 (now U.S. Patent number 6,670,071, the parent case). The Office Action mailed on June 3, 2003 in the parent case states the following:

This application contains claims directed to the following **patentably distinct** species of the claimed invention.

III-1, Claims 20-28, drawn to a method of making an electric storage battery comprising winding together first polarity electrode strip and second polarity electrode strip to form a spiral roll **having at least a portion of the pin within the spiral roll.**

III-2, Claims 39-42 drawn to a method of making an electric storage battery comprising winding together first polarity electrode strip and second polarity electrode strip to form a spiral roll. (Emphasis added)

The only difference in the descriptions for these “**patentably distinct** species” is the language “having at least a portion of the pin within the spiral roll.” As a result, the June 3, 2003 argues that the addition of the limitation “having at least a portion of the pin within the spiral roll” to claim 20 makes claim 20 patentably distinct from claim 39. Since this language makes claims 20 and 39 patentably distinct in the parent application, this language also makes claim 81 in the cited application patentably distinct from claim 79 in the current application. Since the claims are patentably distinct, these claims are not directed to the same invention and the double patenting rejection should be withdrawn.

**Conclusion**

The Applicant respectfully submits that legal error has been made by rejecting the pending claims for statutory double-patenting. For these reasons, allowance of claims 39-41 and 71-80 is respectfully requested.

Respectfully submitted



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